

Application of Joseph Tesler  
Serial No. 09/829,619 filed 4-10-2001  
Response of 3-1-04 to Office Action of 8-29-03

### Response

Receipt is acknowledged of the Office Action dated August 29, 2003. A three month extension of the time provided for response and reconsideration of the application are respectfully requested. The Commissioner is hereby authorized to charge all fees due to Deposit Account No. 50-1604.

In the Office Action, the claims of the application were rejected under §103(a) based on the combination of various references. Reconsideration of the rejection is respectfully requested.

It is respectfully submitted that the present invention is not obvious over any of the references of record, whether considered individually or in combination. Considering the extensive research conducted by the inventor to develop the techniques and products of the present invention, it is respectfully submitted that the present invention cannot be deemed obvious in any manner. A twenty one step process, for example, is shown in Figure 1 (not including the fact that some of those steps then need to be repeated). While all of those steps are not claimed herein, the fact that silk screening had to be modified using such an extensive custom made process to be suitable for use to make religious scrolls demonstrates that the use of silk screening for the present invention is not at all obvious in any manner.

As an example of merely one problem, the placement of ink in silk screening can commonly result in an image which spreads slightly, as the ink is absorbed into the substrate. This is totally undesirable, however, with respect to the printing of a religious scroll, since the spreading of the ink can result in a portion of one letter touching a second letter. If only one letter touches another, the entire scroll is completely invalidated. This traditional problem with the silk screening art indicates that the

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use of silk screening to achieve a religious scroll would be thoroughly unsuitable.

Yet, the present invention takes a text and places it onto animal parchment using a silk screening process despite the fact that the present inventor has learned that such processes commonly result in a spreading of ink which is undesirable for a religious scroll. The fact that contact between any two letters will invalidate an entire scroll, and the fact that the spreading of ink during silk screening can result in the contact of letters, teaches away from the use of silk screening. Yet, the present inventor has nonetheless developed a suitable process for preparing scrolls using silk screening.

In other words, in the case of a Torah scroll over 300,000 letters are placed onto parchment using a method (silk screening) previously known to cause spreading of letters, yet, in accordance with the invention, in all those hundreds of thousands of letters, not even one single letter spreads sufficiently to produce an invalidating defect in the scroll. See e.g., Claim 1. Nor, in all those thousands of letters, is there a single letter with a detached crown. See e.g., Claims 22, 25, 27, 28.

None of the references teach or suggest this result, nor is there any evidence that any prior art process has even been developed that has achieved such a scroll in any manner. The product referred to in the De'iah vi Dibur article could not and did not achieve such a flawless scroll, as expressly admitted in the article. (For example, the article specifically states that in silk screening some of the "tagim" or crowns will be detached from the letters, which is not the case with the method of the present invention). Thus, the article, in fact, only further demonstrates the non-obvious nature of the present invention.

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Moreover, with respect to the Dei'ah veDibur article, Applicant respectfully notes that the Dei'ah veDibur article is not even prior art to the present invention. If that article is being cited as a printed publication, the article is dated March 8, 2000, while the present application claims priority back to a provisional application dated February 23, 2000. Accordingly, as a printed publication, the Dei'ah veDibur article is dated after the effective date of the present application and, therefore, the article itself cannot be prior art.

With respect to the statements in the application referring to the sale or distribution of parchments several weeks prior to the date of the article, such sales or distribution or parchments are also not prior art to the present application. Sections 102(a) expressly indicates that to constitute prior art, the alleged art must be "known or used by others in this country" before the invention thereof by the applicant for patent. However, the alleged activities spoken of in the article were in Bnei Brak (a city in Israel). Since they were not conducted in this country, they do not qualify as prior art under Section 102 or under Section 103 (whose definition of "prior art" is based on Section 102). Those parchments were also not before the invention thereof by the applicant for patent. Likewise, the alleged sale or distribution also does not qualify under 102(b), because it was not "public use or on sale in this country" and also because the alleged activities were not more than a year before the date of the present application. Furthermore, there is nothing to suggest that the article itself or anything cited therein provides an enabling disclosure.

With respect to the Examiner's statement that "kosher" is subjective, the term is intended herein to refer to a legal determination under Jewish law based upon certain objective criteria. With regard

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to kosher parchment, the intent herein is to refer to parchments made from those animals that are classified as kosher animals under Jewish law. Cows, for example, are kosher animals, while pigs are not kosher. For the purposes of the claims, therefore, the type of animal the parchment comes from is intended to be the objective determination with respect to the use of the term "kosher parchment".

With respect to determining whether a given scroll is kosher, Claim 1 has been amended to change that language to specifically recite one of the important criteria of kosherness ("*kashruth*"). Namely, the claim now recites that no two letters in the entire scroll come into contact with each other, which is also an objective criterion.

In summary, traditional silk screening would normally be considered lacking in suitability to for use in preparation of a religious scroll, and there is no teaching or suggestion in any of the references to indicate that the invention of the claims could be achieved other than in complete hindsight reconstruction which is impermissible.

Accordingly, in view of the above, it is respectfully submitted that the pending claims are fully patentable over all of the art of record. Favorable action on all of the claims is respectfully requested and believed fully warranted.

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Respectfully submitted,



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